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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,807	09/19/2001	Si Lok	98-17C1	1783

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EXAMINER
O HARA, EILEEN B

ART UNIT	PAPER NUMBER
1646	6

DATE MAILED: 11/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	09/955,807	LOK ET AL.	
	Examiner	Art Unit	
	Eileen B. O'Hara	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-7 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-7 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1 and 2, drawn to polypeptides comprising all or portions of SEQ ID NO: 2, classified in class 530, subclass 350.

II. Claims 3 and 4, drawn to polynucleotides encoding the polypeptide of SEQ ID NO: 2 and vector comprising, classified in class 536, subclass 23.5 and 435, 320.1.

III. Claim 5, drawn to antibody that specifically binds to polypeptide of SEQ ID NO: 2, classified in class 530, subclass 387.9, for example.

IV. Claim 6, drawn to anti-idiotypic antibody to an antibody that specifically binds to polypeptide of SEQ ID NO: 45, classified in class 530, subclass 387.2.

V. Claim 7, drawn to a method for promoting proliferation of leukocytes comprising contacting leukocytes with a polypeptide of SEQ ID NO: 2, classified in class 424, subclass 85.7, for example.

The inventions are distinct, each from the other because of the following reasons:

The polynucleotides of invention II are related to the polypeptide of Invention I by virtue of encoding the same. The polynucleotides can be used to recombinantly produce the polypeptide in a host cell. Although the polynucleotides and polypeptide are related since the polynucleotides encode the specifically claimed proteins, they are distinct inventions because the protein product can be made by another materially different process, such as by synthesis or

purification from the natural source. Further, the polynucleotides may be used for processes other than the production of the polypeptide, such as nucleic acid hybridization assays.

The proteins that are invention I are related to the antibodies of invention III by virtue of being the cognate antigen, necessary for the production of the antibodies. Although the proteins and antibodies are related due to the necessary stearic complementarity of the two, they are distinct inventions because they are physically and functionally distinct chemical entities, and because the protein can be used in another and materially different process from the use for the production of the antibody, such as in a pharmaceutical composition in its own right, or to assay or purify the natural protein.

Inventions I and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptides can be used in the method for promoting proliferation of leukocytes of invention V, but the polypeptides can also be used in a method of generating antibodies, which is a materially different method.

Invention II and each of inventions III and V are related as a process of making and a process of using a common product. The polynucleotides of invention II encode the polypeptides, which can be used in a method of generating the antibodies of invention III or in the method for promoting proliferation of leukocytes of invention V. They are distinct inventions because they are either structurally and functionally distinct compounds or the polynucleotides of invention II are not used in the method of invention V.

The antibodies of invention III are related to the anti-idiotypic antibodies of invention IV by virtue of being the cognate antigen, necessary for the production of the anti-idiotypic antibodies. Although the antibodies and anti-idiotypic antibodies are related due to the necessary stearic complementarity of the two, they are distinct inventions because they are physically and functionally distinct chemical entities, and because the antibodies specifically bind to the proteins of invention I, while the anti-idiotypic antibodies bind to antibodies of invention III, and not the proteins of invention I. Additionally, the antibodies of invention III can be used in a method of purifying the protein, which is another and materially different process from the use for the production of the anti-idiotypic antibodies.

Inventions I and II are each unrelated to invention IV. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different structures and different activities.

Inventions III and IV are also unrelated to invention V. The antibodies and anti-idiotypic antibodies are not used or defined in the method for promoting proliferation of leukocytes of invention V.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, recognized divergent subject matter and the need for non-coextensive literature search, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (703) 308-3312. The examiner can normally be reached on Monday through Friday from 10:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

Official papers Before Final filed by RightFax should be directed to (703) 872-9306.

Official papers After Final filed by RightFax should be directed to (703) 872-9307.

Official papers filed by fax should be directed to (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Eileen B. O'Hara, Ph.D.
EBA 11/20/02
Patent Examiner

Lorraine Spector
LORRAINE SPECTOR
PRIMARY EXAMINER